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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,078	07/09/2004	Urs Burckhardt	120346	3301
25944	7590	11/25/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			YAO, SAMCHUAN CUA	
			ART UNIT	PAPER NUMBER
			1733	
DATE MAILED: 11/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/501,078	Applicant(s) BURCKHARDT ET AL.	
	Examiner Sam Chuan C. Yao	Art Unit 1733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/501,078</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-6, 10-11, 13-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pfenninger et al (US 6,136,942).

With respect to claims 1-3, 6, 10 and 14-20, Pfenninger et al discloses a moisture curable one-component polyurethane composition for use as a sealant, adhesive, coating composition, etc. (abstract; col. 1 lines 16-32; col. 9 lines 56-64). The composition comprises a) a polyurethane prepolymer, which is formed from a polyisocyanate such as a diisocyanate and polyols such as polyetherpolyols; wherein the polyols advantageously have a "*low unsaturation level (<0.07 double bond equivalents/mole)*" and an average molecular weight ranging from 500-20,000 g/mole" (hence, this translates to a polyol unsaturation level of: 0.0035 meq/g to 0.14 meq/g); and, b) a polyaldimine which is a reaction product of diamine and aldehyde

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(col. 2 line 27 to col. 7 line 45; col. 8 lines 4-59; examples 9-10). Since the recited unsaturation degree of polyols significantly overlaps the unsaturation degree range taught by Pfenninger et al, the recited unsaturation degree is taken to be anticipated by the unsaturation degree range taught by Pfenninger et al. In any event, absent any showing of unexpected result, the unsaturation degree for polyols recited in claims 1, 3, 6 would have been obvious in the art because one in the art would have applied a workable unsaturation degree for polyols suggested by Pfenninger et al, which would include the unsaturation degree recited in these claims.

With respect to claim 5, see column 7 lines 31-34.

With respect to claims 11 and 13, see column 4 lines 33-60.

With respect to claim 21, see examples 9-10. Since: a) the composition in these examples is used as an adhesive or coating material for a fir-wood, b) fir-wood is taken to inherently contain at least to a certain degree some moisture, the composition is taken to be inherently applied to an hydrous component. In any event, it would have been obvious in the art to apply the moisture curable composition of Pfenninger et al onto a hydrous material as such is well known in the art.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfenninger et al (US 6,136,942) as applied to claim 1 above.

With respect to claim 4, it is conventional in the art to use a double metal cyanide (DMC) as a catalyst for a production of polyoxyalkylene to inhibit/minimize the formation of by-product.

With respect to claims 7-8, as noted above, a polyol unsaturation level and average molecular weight of the polyols suggested by Pfenninger et al ranges from: 0.0035 meq/g to 0.14 meq/g, and 500-20,000. Since: a) it is now well settled that "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the same very same purpose ..." (MPEP 2144.06), b) it is well within the purview in the art to apply a workable range suggested by a prior art reference and the determine a suitable amount of polyols, claim 7 would have been obvious in the art. As for claim 8, see column 7 lines 43-45.

With respect to claim 9, the recited polyols in this claim is conventional in the art of making a moisture curable polyurethane composition.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfenninger et al (US 6,136,942) as applied to claim 1 above, and further in view of Buetjer et al (US 4,469,831).

Since it is well known in the art to formulate a moisture curable polyurethane composition from a polyaldimine and a polyurethane prepolymer having NCO functionality, where the ratio of NCO and aldimine is around 1.3:1 to 1:1, preferably

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1:1 as exemplified in the teachings of Buetjer et al (col. 5 lines 3-11), it would have been obvious in the art make the composition of Pfenninger et al such that the ratio of NCO and aldimine is around 1.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
11-21-05